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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,551	05/25/2000	William Y. Conwell	60204	5990

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EXAMINER
ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
2177	9

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/578,551	CONWELL ET AL.	
	Examiner	Art Unit	
	Mohammad Ali	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *7* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. This communication is responsive to the amendment filed on November 27, 2002, Paper No. 8.

Specification

2. Claims 15, 22, and 24 objected to because of the following informalities: The word "internet" should be written as "Internet". Appropriate correction is required. Same correction is required in the specification page 1, line 27 and subsequent pages.

Response to Arguments

3. Claims 1-27 are pending in this Office Action.

After a further search and a thorough examination of the present application, claims 1-27 remain rejected.

Applicant's arguments with respect to claims 1-27 have been considered, but they are not deemed to be persuasive.

First, Applicant argues that Eyal does not teach, "deriving an identifier from an existing media content object".

In response to Applicant's arguments, the Examiner respectfully submits that in particular, Eyal teaches this limitation as, each media site provide access to media through one or more media links available (existing) at the site or through other means. The media links identify web resources having media content (col. 12, lines 13-17).

Second, Applicant argues that Davis/Eyal does not teach, "for a predetermined period commencing with said first bid".

In response to Applicant's arguments, the Examiner respectfully submits that in particular, Davis teaches this limitation as, since the cost of a search listing is calculated by multiplying the bid amount during a specified time period (predetermined), every cost projection algorithm must generally determine an estimate number of clicks per month or other specified time period for a search listing (col. 21, lines 7-13).

Third, Applicant argues that Davis/Eyal does not teach, "for a predetermined period with an identifier".

In response to Applicant's arguments, the Examiner respectfully submits that in particular, Davis teaches this limitation as, predefined report types includes activity tracked during the time period and the reports includes identification data (col. 22, lines 10-19).

Fourth, Applicant argues that Thomas does not teach, "MP3 audio file".

In response to Applicant's arguments, the Examiner respectfully submits that in particular, Thomas teaches this limitation as, within the preliminary time set contains files, those files contain potentially infringing materials like as mp3 music file (col. 6, lines 62-65).

Finally, applicant argues "absent impermissible use of hindsight".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In light of forgoing arguments, the 102, 103 rejections are hereby sustained.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 14, 16, 17, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,269,361 B1 issued to Davis et al. ('Davis', hereinafter).

As per claim 14, Davis discloses a method of managing a universe of identifiers, some of said identifiers being active and having Internet resources associated therewith (col. 7, lines 33-40). The

claimed step of, 'others of said identifiers being inactive, the method including receiving a query corresponding to an inactive identifier' is disclosed Davis as search engine program permits network users, upon navigating to the search engine web servers capable of submitting queries to the search engine web server through their browser program, to type keyword queries to identify pages interest among the millions page available on the World Wide Web. The users will get result with active and inactive web pages (col. 8, lines 55-65 et seq). Finally, the claimed step of 'in response, initiating a time-limited auction, a winner of said auction being granted the privilege of associating an internet resource with said identifier for at least a predetermined time period' since the cost of a search listing is calculated by multiplying the bid amount during a specified time period (predetermined), every cost projection algorithm must generally determine an estimate number of clicks per month or other specified time period for a search listing (col. 21, lines 7-13).

As to claim 16, Davis discloses 'a method of auctioning to the highest bidder the privilege of defining a link that is to be associated, for predetermined time period, with an identifier through a database' as since the cost of a search listing is calculated by multiplying the bid amount during a specified time period (predetermined), every cost projection algorithm must generally determine an estimate number of clicks per month or other specified time period for a search (database) listing (col. 21, lines 7-13). The claimed step of 'at expiry of said predetermined time period, reauctioning said privilege' is disclosed Davis as the daily run rate to obtain a projected number of days to exhaustion or expiration in the time period (col. 21, lines 23-25 et seq).

As per claim 25, 'automatically deriving the identifier using a device maintained by said winner, without requiring said winner to type or otherwise manually enter the identifier' is disclosed Davis as automatic notification will be sent to the advertiser at that time at col. 16, lines 14-15 et seq.

As per claim 17, 'proceeds of said re-auctioning are shared with the high bidder,...' is disclosed Davis at col. 21, lines 19-25

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

" A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

If this application currently names joint inventors, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary in considering patentability of the claims under 35 U.S.C. § 103. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

7. Claims 1-5, 7-12, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,269,361 issued to Davis et al. ('Davis', hereinafter), in view of US Patent 6,389,467 issued to Aviv Eyal ('Eyal', hereinafter).

As per claim 1, Davis discloses a method of operating database that plural records, the method including receives queries, each including an identifier, and replying to said queries by reference to information for database records associated with said identifiers, said identifiers being drawn from a universe of possible identifiers, a majority of which do not have active database records associated therewith (col. 8, lines 55-65 et seq). The claimed step of, 'receiving a query from a user including an identifier,....'is disclosed in Davis paten as the bid amount is included on the identification and the search result list is preferably combined with "non-paid" web site descriptions generated by a conventional Internet search engine, preferably including listings generated according to mathematics-based database search algorithms. The combination of paid and unpaid listings helps ensure that the searcher will receive the most complete and relevant search results (col. 5 lines 42-50). Finally, claimed step of 'permitting the user to create an active database record,...' is disclosed Davis as create a new system of advertising where advertisers target the most interested consumers by participating in a free market which attaches a monetary cost for an advertiser's listing in a search result list generated using advertiser-selected search terms (col. 4 lines 34-48). Although Davis discloses media content object, which appear to be analogous to content in the Internet browsing, the reference does not specifically

detail a media content object as depicted in figure 2 of the present application. However, Eyal discloses an analogous method wherein each media site provide access to media through one or more media links available (existing) at the site or through other means. The media links identify web resources having media content that substantially receive and permit in the requested object from the media (col. 12, lines 13-17). It would have been to obvious one ordinarily skilled in the art at the time of processing queries, at the present invention to combine the teachings of the cited references because the media content object of Eyal's method would have provided Davis's with necessary infrastructure, which would allow the media content object to generate their respective queries, as explained in Eyal, col. 12, lines 13-17 et seq.

As per claim 4, Davis discloses a method deriving an identifier conrresponding,... (Abstract, lines 22-34). The claimed step of, 'querying the database with the derived identifier' is disclosed Davis as determines where the network information providers listing will appear on the search results list page that is generated in response to a query of the search term by searcher located at a client computer on the computer network (Abstract, lines 27-34). Finally, the claimed step of, '....,permitting a party who first queried the database,...' is disclosed Davis as create a new system of advertising where advertisers target the most interested consumers by participating in a free market which attaches a monetary cost for an advertiser's listing in a search result list generated using advertiser-selected search terms (col. 4 lines 34-48).Although Davis discloses media content object, which appear to be analogous to content in the Internet browsing, the reference does not specifically detail a media content object as depicted in figure 2 of the present application. However, Eyal discloses an analogous method wherein each media site provide access to media through one or more media links available (existing) at the site or through other means. The media links identify web resources having media content that substantially receive and permit in the requested object from the media (col. 12, lines 13-17). It would have been to obvious one ordinarily skilled in the art at the time of processing queries, at the present invention to combine the teachings of the cited references because the media content object of Eyal's method would have provided Davis's with necessary infrastructure, which would allow the media content object to generate their respective queries, as explained in Eyal, col. 12, lines 13-17 et seq.

As to claim 5, Davis teaches '...,audio file' at col. 8, lines 15-18.

As per claim 2, Davis teaches '....,allowing the user to pay fee,...' at col. 5 lines 35-51.

As per claim 3, Davis teaches, 'allowing the user to make a first bid,...' at Abstract, lines 27-34.

As to claim 7, Davis teaches, '...,video file' at col. 8, lines 15-18.

As to claim 8, Davis teaches, 'deriving includes consulting resource,...' at col. 8, lines 15-18.

As per claim 9, Davis teaches, 'resource is database' at col. 6, lines 16-25.

As per claim 11, Davis teaches, 'several identifiers corresponds,...' at col. 5, lines 35-43.

As per claim 10, Davis teaches, 'deriving includes processing data,...' at col. 5, lines 35-43.

As per claim 12, Davis teaches, 'identifiers automatically generated from the different audio,...' at col. 8, lines 15-18.

As per claim 20, 'a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services and that are offered by commercial entities, and said user is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities' is disclosed Davis as in the Internet, advertiser web servers are connected to the commercial information service (col. 7, lines 45-55 et seq).

As per claim 21, 'automatically providing the identifier from a process on a user device - such as a computer - to the database, without requiring the user to type or otherwise manually enter the identifier' is disclosed Davis as receives data identifying the advertiser and retrieves advertiser's account from the database (col. 14, lines 38-39 et seq).

As per claim 22, 'a primary function of the database is to link consumers to internet resources, such as web pages, that promote goods or services that are related to media content objects and that are offered by commercial entities, and said party is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities' is disclosed Davis as in the Internet, advertiser web servers are connected to the commercial information service (col. 7, lines 45-55 et seq).

As per claim 23, 'automatically providing the identifier form a process on a device maintained by said party-such as a computer-to database, without requiring said party to type or otherwise manually

enter the identifier' is disclosed Davis as automatic notification will be sent to the advertiser at that time (col. 16, lines 14-15 et seq).

8. Claims 15, 18, 19, 24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,269,361 issued to Davis et al. ('Davis', hereinafter) as applied to claims 14, 16, 17, and 25 in view of US Patent 6,389,467 issued to Aviv Eyal ('Eyal', hereinafter).

As per claim 15, Davis teaches, "active identifiers correspond,....' as the bid amount is included on the identification and the search result list is preferably combined with "non-paid" web site descriptions generated by a conventional Internet search engine, preferably including listings generated according to mathematics-based database search algorithms. The combination of paid and unpaid listings helps ensure that the searcher will receive the most complete and relevant search results (col. 5 lines 42-50).

As per claims 18, Davis teaches 'identifier corresponds and derived,....' as determines where the network information providers listing will appear on the search results list page that is generated in response to a query of the search term by searcher located at a client computer on the computer network (Abstract, lines 27-34).

As per claim 19, Davis teaches 'identifier corresponds and derived,....'as determines where the network information providers listing will appear on the search results list page that is generated in response to a query of the search term (Abstract, lines 27-29).

As per claim 24, 'identifiers and internet resources are associated through a database, a primary function of which is to link consumers to internet resources that promote goods or services that are related to objects and that are offered by commercial entities, and said winner is one of said consumers, wherein the consumer can participate in such linking in a manner customarily reserved to the commercial entities' is disclosed Davis as in the Internet, advertiser web servers are connected to the commercial information service (col. 7, lines 45-55).

As per claim 26, 'a primary function of the database is to link consumers to internet resources that promote goods or services' is disclosed Davis as in the Internet connection with client and server computer commercial information services are available (col. 7, lines 50-55 et seq)

As per claim 27, 'includes automatically deriving the identifier' is disclosed Davis as receives data identifying the advertiser and retrieves advertiser's account from the database (col. 14, lines 38-39 et seq) .

9. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,269,361 issued to Davis et al. ('Davis', hereinafter) in view of US Patent 6,389,467 issued to Aviv Eyal ('Eyal', hereinafter), as applied to claims 1-5, 7-12, and 20-23 and further in view of US Patent 6,401,118 issued to Jason Thomas ('Thomas', hereinafter).

As per claim 6, although Davis and Eyal discloses MP3 audio file, which appear to be analogous to media content in the Internet browsing, the references do not specifically detail of MP3 audio file as depicted in figure 2 of the present application. However, Thomas discloses an analogous method wherein within the preliminary time set contains files, those files contain potentially infringing materials like as mp3 music file (col. 6, lines 62-65). It would have been to obvious one ordinarily skilled in the art at the time of processing queries with MP3 file, at the present invention to combine the teachings of the cited references because the MP3 audio file of Thomas's and media content object of Eyal's method would have provided Davis's with necessary infrastructure, which would allow the to process the MP3 audio file with media content object to process their respective files, as explained in Thomas, col. 6, lines 62-65 et seq.

As per claim 13, although Davis and Eyal discloses MP3 audio file, which appear to be analogous to media content in the Internet browsing, the references do not specifically detail of MP3 audio file as depicted in figure 2 of the present application. However, Thomas discloses an analogous method wherein within the preliminary time set contains files, those files contain potentially infringing materials like as mp3 music file (col. 6, lines 62-65). It would have been to obvious one ordinarily skilled in the art at the time of processing queries with MP3 file, at the present invention to combine the teachings of the cited references because the MP3 audio file of Thomas's and media content object of Eyal's method would have provided Davis's with necessary infrastructure, which would allow the to process the MP3 audio file with media content object to process their respective files, as explained in Thomas, col. 6, lines 62-65 et seq.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (703) 605-4356. The examiner can normally be reached on Monday to Thursday from 7:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Mohammad Ali

Patent Examiner

February 03, 2003

JEANNE HOMERE
PRIMARY EXAMINER